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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/976,342 11/17/92 HARRIS

32M1/0923

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E 3672/81-1446
EXAMINER
SMITH, S

ART UNIT PAPER NUMBER

3204

DATE MAILED: 09/23/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input checked="" type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-8 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-8 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 324

1. The specification is objected to since it does not contain proper headings.

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (i) Abstract of the Disclosure.

2. Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite since several recitations fail to positively set forth the invention such as "adapted to clinch" on line 3 of claim 1, "adapted to move" on line 12 of claim 1, "associated with" on line 14, "means associated with" on line 17 of claim 1, "adapted to engage" on line 3 of claim 2,

"being adapted to be moved" on line 4 of claim 2, "being associated with" on lines 4 and 5 of claim 4, "adapted to engage" on line 2 of claim 5 and "adapted to bias" on line 4 of claim 8. Positive recitations should be made such as "for clinching", "for moving", "operatively connected to", "connected to", "for engaging" and "for biasing" for example. In claim 2, line 3, the recitation of "a toggle having part" is confusing. Claim 2 is indefinite since "the spring" on line 5 lacks proper antecedent basis. In claim 3, line 3, what does "it" refer to? This is indefinite. Claim 4 is indefinite since "the first arm actuating element" on line 6 lacks proper antecedent basis. Claim 4 recites "means being provided to operate the toggle". Isn't this means the same as the other arm. This appears to be redundant. Claim 4 is indefinite since "the free end" on lines 2 and 3 and "said predetermined extent" on lines 4 and 5 lacks proper antecedent basis.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit 324

4. Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Balma '729.

Balma '729 discloses a plier stapler comprising a first arm 5 pivotally connected to a second anvil arm 30, a magazine carried on the first arm, an ejector blade 12, an actuator element 47 retained in a first position via spring 15 and being actuated via handle means 40, 45, 46.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Art Unit 324

6. Claims 2 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Balma '729 in view of Olney et al.


Balma '729 lacks the toggle retaining means. Olney et al. discloses an actuating means 38-40 retained in a loaded state via a toggle 32, said toggle being biased by a spring 35 to a position retaining said actuating means, wherein the toggle is movable to a non-engaged position with the actuating means when a predetermined force has been applied. In view of the teachings of Olney et al., it would have been obvious to one skilled in the art to provide the stapler of Balma '729 with a toggle retaining means in order to provide an increased driving force.

7. Claims 4-8 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson, Krantz, Obstfeld et al., Peterson, Balma '505 and Kohen et al. disclose various staplers.

9. Any inquiry concerning this communication should be directed to Scott Smith at telephone number (703) 308-2190.


Smith/msm
September 13, 1993


SCOTT SMITH
PATENT EXAMINER
GROUP 3200